

Remarks

The specification and claim 15 have been amended. Claims 17-27 and 30-37 have been canceled, and new claims 38-40 have been added. Review and reconsideration in light of the amendments and the remarks below are requested.

The Office action objects to the drawings for not showing the subject matter of claims 34 and 36. Claims 34 and 36 are also rejected under 35 U.S.C. §112 on the basis that stating that the backing portion has a non-skid surface is allegedly new matter. However, by this Amendment claims 34 and 36 have been canceled.

Claims 35 and 37 are rejected under 35 U.S.C. §112 on the basis that the limitation that the anti-static coating covers substantially the entire upper surface of each sheet allegedly constitutes new matter. However, by this Amendment claims 35 and 37 have been canceled.

Claims 1-8, 10-14, 28 and 29 are rejected as defining obvious subject matter over Great Britain Patent 2,289,520 in light of U.S. Pat. No. 1,906,261 to Glass. This rejection is respectfully traversed for the reasons outlined below.

The Great Britain patent is cited for showing a plurality of stacked sheets, wherein each sheet is joined to another sheet along at least two separate edges. The Office action admits that the Great Britain patent does not disclose a calendar portion on each of the stacked sheets, wherein the calendar portion has a period of at least one week. The Great Britain patent also does not disclose chronologically arranged sheets.

The Glass reference is then cited as disclosing a monthly calendar portion. The Office action concludes that it would have been obvious to one of ordinary skill to modify the Great Britain patent to place a monthly calendar portion on each of the sheets. However, such a combination is traversed on the basis that the Great Britain patent specifically teaches against such a modification.

In particular, the Great Britain patent discloses that the purpose of the mousepad of that patent is to provide sheets which can be removed once sufficient debris accumulates thereon to reveal a clean sheet underneath for use. For example, as noted at page 1, second full paragraph of the "Background" section, the Great Britain patent notes that prior art mouse pads can impede the effective use of a mouse thereon by the buildup of substances such as airborne glue, dust, ink or dirt. The Great Britain patent then notes that the debris on the surface of the pad is transferred

to the ball mechanism of the mouse, as shown in Fig. 2 of the Great Britain patent. The buildup of debris causes the mouse to operate irregularly and requires cleaning of the ball mechanism on a regular basis.

As further noted in the Abstract, the Great Britain then patent indicates that it is directed to a mouse pad wherein a sheet of paper can be removed "whenever necessary" to reveal a clean top sheet for use. Accordingly, the Great Britain patent discloses that sheets are torn from the mouse pad and disposed, *as necessary*, when the top sheet accumulates sufficient debris.

In contrast, the Glass reference discloses a calendar having a plurality of sequentially arranged sheets. Each sheet is designed to be removed at the end of the month in the manner of a standard calendar (see page 1, lines 40-43; see also page 1, lines 83-85). Thus, the Glass reference teaches the removal of a sheet at predetermined time intervals.

Accordingly, it can be seen that the teachings of the Glass reference and Great Britain reference are conflicting. If the calendar portions of the Glass reference (i.e., calendar sheets arranged in sequential order) were to be reproduced on the sheets of the Great Britain patent, then the very purpose and teaching of the Great Britain patent (i.e., removing sheets when sufficient debris is located thereon) is undermined. For example, if a top sheet of the modified Great Britain mouse pad were to prematurely accumulate a large amount of debris located thereon, then the top sheet would have to be removed prior to the expiration of the calendar period, thereby negating the usefulness of the calendar indicia. Conversely, if the top sheet remains sufficiently clean for longer than a month, the top sheet will nevertheless be required to be removed in order for the calendar to serve a useful purpose, which contravenes the teaching of the Great Britain patent and shortens the useful life of the mouse pad.

Accordingly, as noted above, as the very purpose and thrust of the Great Britain patent is to disclose a mouse pad from which sheets can be removed as necessary once sufficient debris accumulates thereon, it is submitted that the proposed combination contravenes the purpose of the Great Britain patent. Although the Great Britain patent does disclose (i.e., at the fourth full paragraph of page 1) that a calendar may be located on the sheets, presumably the calendar portion disclosed therein would be for a relatively long period, such as a year or more. In this case the calendar portion printed on each sheet would likely be identical and could be removed once they become dirty and not impede the usefulness of the mousepad.

Thus it is submitted that one of ordinary skill in the art would not be motivated to modify the calendar of the Great Britain patent in the manner proposed in the Office action, given the teachings of the Great Britain patent.

New claim 39, which depends from 28, specifies that the uppermost one of the stacked sheets is removed at the end of the calendar portion printed thereon. It is submitted that, even if the cited references were combined in the proposed manner, the subject matter of claim 39 would not be shown, given that the Great Britain patent teaches removing a sheet once sufficient debris is accumulated thereon. The specification has been amended to provide specific support for the subject matter of claim 39. Support for this amendment can be found, for example, at page 3, lines 22-25 of the originally filed application.

A 37 C.F.R. §1.132 accompanies this Amendment. The Declaration states that MeadWestvaco (the assignee of this application) sold 115,919 units of the mousepad calendars in 2002, 117,997 units in 2003, 124,047 units in 2004, and 110,531 units though mid-June of 2005. Thus, since the introduction of the mousepad calendar in 2002 MeadWestvaco has sold 468,484 units and derived \$1,474,922 in gross revenue. In addition, sales have shown a steady increase since the mousepad's introduction.

MeadWestvaco does not, in general, sell or market the mousepad calendars to the general public, but instead sells to retailers. Major retailers such as Wal-Mart, K-Mart, Office Max, Staples, Office Depot, Safeway, and Carlton Cards have purchased the mousepad calendars from MeadWestvaco for sale to others. It is submitted that the commercial success of the invention is even more impressive given the fact that the mousepad calendar essentially created a new product line (as evidenced by the fact that there is no identical product cited in an Office action). Thus MeadWestvaco's sales of the mousepad calendar must typically displace more commercially accepted products, such as traditional wall-hanging calendars or mousepads.

In addition, this commercial success has been achieved without great advertising expenditures. In particular, MeadWestvaco does not market the mousepad calendar to the general public. In addition, MeadWestvaco does not directly mark the mousepad calendar to its retail customers. Instead the mousepad calendar is merely included as an item for purchase in MeadWestvaco's large catalogs, which typically includes hundreds of other items for purchase.

Thus it is submitted that the commercial success of the invention provides secondary indicia of non-obviousness.

New claims 38 and 40 depend from claims 1 and 28, respectively, and specify that each sheet is not directly joined to any adjacent sheet along an intermediate location of each edge thereof such that a user can slide a finger between the sheets at the intermediate location of each edge. The specification has been amended to provide support for new claims 38 and 40. It is submitted that this amendment does not add any new matter on the basis that the specification already discloses that a user can slide his or her finger at an intermediate location between the attached corners of the sheets, and lift the uppermost sheet upwardly to tear the adhesive and break the uppermost sheet away from the bulk of the mouse pad calendar (page 4, lines 7-12). In addition, the adhesive is disclosed as being located at the corners of the sheet (page 3, line 30 - page 4, line 2) and Fig. 3 illustrates the adhesive 20 located only at the corners thereof.

In contrast the Great Britain patent discloses an adhesive extending along the entire length of at least two edges thereof. Locating the adhesive only at the corners allows greater flexibility to the user in the manner in which the topmost sheet can be removed. Thus it is submitted that new claims 38-40 further distinguish over the cited references.

Therefore it is submitted that the application is in a condition for allowance, and a formal notice thereof is respectfully requested.

Applicant hereby petitions under 37 C.F.R. §1.136 for an extension of time of one month to respond to the outstanding Office action. Attached is a check including the amount of \$120 for response within the first month extension of time. (37 C.F.R. §1.17(c)).

The Commissioner is hereby authorized to charge any additional fees required, including the fee for an extension of time, or to credit any overpayment to Deposit Account 20-0809. The applicant(s) hereby authorizes the Commissioner under 37 C.F.R. §1.136(a)(3) to treat any paper that is filed in this application which requires an extension of time as incorporating a request for such an extension.

Respectfully submitted,



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Amendment

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